REMARKS

Claims 1-30 are pending in the Application and all were rejected by the Office Action. Claims 1, 3, and 11 are amended by this response. Claims 1, 11, 16 and 24 are independent claims. Claims 2-10, 12-15, 17-23 and 25-30 depend either directly or indirectly from independent claims 1, 11, 16 and 24, respectively.

Claims 1, 3, and 11 are amended by this response. Support for these amendments may be found, at least, at paragraph [0063]-[0067] and [0076] of the Specification. Applicants respectfully submit that no new matter is added by these amendments.

The Applicants respectfully request reconsideration of pending claims 1-30, in light of the following remarks.

Rejections of Claims

Claims 1-30 were rejected under 35 U.S.C. §103(a) as being anticipated by Moles et al. (US 6,615,038, hereinafter "Moles") in view of Shah (US 6,047,071). The Applicants respectfully traverse the rejection. Applicants respectfully submit that the claims define allowable subject matter, for at least the reasons set forth during prior prosecution, and for the reasons set forth below.

The Applicants respectfully submit that the Examiner has failed to establish a case of prima facie obviousness for at least the reasons provided below. M.P.E.P. §2142 clearly states that "[t]he examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness." The M.P.E.P. §2142 goes on to state that "[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the

claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure."

The Applicants note that every claim rejection is based on obviousness. "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is **not** whether the differences themselves would have been obvious, but whether the claimed invention <u>as a whole</u> would have been obvious." MPEP at § 2141.02. The law is well settled that "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so." *ACS Hospital Systems, Inc. v. Montfiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929 (Fed. Cir. 1984). It is not permissible to pick and choose among the individual elements of assorted prior art references to re-create the claimed invention, but rather "some teaching or suggestion in the references to support their use in the particular claimed combination" is needed. *Symbol Technologies, Inc. v. Opticon, Inc.* 935 F.2d 1569, 1576, 19 USPQ2d 1241 (Fed. Cir. 1991).

Although, as argued in the response to the Office action of July 17, 2007, the Applicants believe that motivation to combine has not been shown, the Applicants do not re-argue this point in this response as the Applicants wish to bring other arguments to light. However, the Applicants reserve the right to further argue the lack of motivation to combine in the future.

Traversal of Official Notice

The Office Action states the following in the Response to Arguments section:

> Examiner understands Applicants arguments. Whatever the amount of complexity that Applicants might argue that the claim may be, the claim itself only states, "... to update at least one software or firmware ...." As disclosed in the previous Office action and cited by Applicants on page 17 of the Remarks, Shah discloses a mobile phone that is programmed with a service option for changing the NAM parameter (i.e., updating of software or firmware) and that updating is done using OTASP.

Accordingly, the Office Action seems to be implying that changing NAM parameters is updating of software or firmware. However, the references Moles and Shah do not disclose that changing NAM parameters is updating of software or firmware. Therefore,

the Applicants assume that the Office Action is making an Official Notice. The Applicants traverse this Official Notice.

Assuming that the Office Action is asserting Official Notice that the subject of the above listed statements is common knowledge, the Applicants respectfully traverse the perceived and explicit assertions as further set forth below. Alternatively, if the Office Action's assertions are based on the personal knowledge of the Examiner, then under MPEP § 2144.03(C) and 37 C.F.R. § 1.104(d)(2), the assertions must be supported by an affidavit from the Examiner.

According to MPEP § 2144.03(A), Official Notice, without supporting references, should **only** be asserted when the subjects asserted to be common knowledge are "capable of instant and unquestionable demonstration as being well-known." That is, the subjects asserted must be of "notorious character" under MPEP § 2144.03(A).

However, the Applicants respectfully submit that the subject matter of the perceived Official Notice, as stated in pages 4 of the Office Action, is not well-known in the art as evidenced by the searched and cited prior art. The Applicants respectfully submit that the Examiner has performed "a thorough search of the prior art," as part of the Examiner's obligation in examining the present application under MPEP § 904.02.

Additionally, the Applicants respectfully submit that the Examiner's searched and cited references found during the Examiner's thorough and detailed search of the prior art are indicative of the knowledge commonly held in the art. The Applicants respectfully submit that if the subject matter of these assertions of Official Notice had been of "notorious character" and "capable of instant and unquestionable demonstration as being well-known" under MPEP § 2144.03(A), then the subject matter would have appeared to the Examiner during the Examiner's thorough and detailed search of the prior art.

If the Examiner had found any teaching of relevant subject matter, the Examiner would have been obligated to list the references teaching the relevant subject matter and make a rejection. Consequently, the Applicants respectfully submit that the prior art

does not teach the subject matter of the perceived assertions of Official Notice and respectfully traverses the perceived assertions of Official Notice.

Claims construed in light of the Specification

Furthermore, the M.P.E.P. states that claims should be construed in light of the specification. M.P.E.P 608.01(o). The Applicants' specification distinguishes software/firmware from NAM parameters in numerous places. For example, "an OTAPA process may be employed not only to program NAM parameters but also for initiating firmware updates or for setting flags and parameters facilitating subsequent firmware updates." Paragraph [00101], lines 5-7. *See* also paragraphs [0041], [0050] – [0052], [0054] – [0056], [0058], [0060] – [0061], [0063] – [0064], [0067], [0072], and [0076].

Accordingly, the Applicants respectfully submit that the arguments in the "Response to Arguments" section fails because the Applicants' specification sufficiently distinguished NAM parameters from firmware and/or software in an electronic device. Accordingly, the Applicants respectfully submit that claims 1-30 are allowable in light of the Applicants' previously presented arguments. The arguments presented for the previous Office action are substantially restated below for the Examiner's benefit.

Rejection of Claims 1-10

Regarding amended claim 1, the Applicants respectfully submit that the proposed combination of Moles and Shah fails to teach, suggest, or disclose, for example, "...[a] mobile electronic device network employing provisioning techniques for updating electronic devices, the network comprising a device server capable of dispensing at least one update; an electronic device having at least one of firmware and software, the electronic device being communicatively coupled to the device server; an update service in the electronic device, presence of the update service in the electronic device being determinable by the network, wherein when enabled the update service indicates to the network capability of the electronic device to update the at least one of firmware and software, electronic device employing the at least one update to update the at least one of firmware and software; and wherein one or more parameters specific

to updating of firmware and software in the electronic device are provisioned during provisioning of a number assignment module (NAM) in the electronic device, by the network."

The Applicants appreciate recognition by the Office that Moles does not disclose "... a network comprising an update service in the electronic device, presence of the update service in the electronic device being determinable by the network, wherein when enabled the update service indicates to the network capability of the electronic device to update at least one of firmware and software, electronic device employing the at least one update to update the at least one of firmware and software." Office Action, pages 5-6. The Office Action, however, alleges that Shah remedies the admitted shortcomings of Moles, and cites Shah at Abstract and at column 2, lines 30-60.

According to Shah, at the Abstract:

> The procedure for Over-The-Air Parameter Administration (OTAPA) utilizes the over-the-air programming protocol and procedures which support the Over-The-Air Service Provisioning (OTASP) feature in accordance with established industry standards (TIA/EIA/IS-683). The mobile phone is programmed with a service option for changing the NAM parameters including an identification number for this option. The network base station sends a message to the mobile phone using the identification number and, if the mobile phone has OTAPA capability, it responds indicating support. The base station then transmits message telling the mobile station to proceed to the Traffic Channel and inquires whether the encryption mode is enabled, proceeding with the OTAPA only if the encryption mode is enabled. Once on the Traffic Channel, a Parameter Change Code (PCC) is sent. If the PCC is verified by the mobile unit, the base station proceeds to update the parameters and store the updated parameters into the phone's memory. After verification of the programmed data in accordance with OTASP processing, the process is terminated. No user intervention is required to initiate or conduct the OTAPA procedure.

The Applicants respectfully submit that the above portion of Shah, which was explicitly cited by the Office Action, fails to teach or disclose anything with respect to the

update of firmware or software, and therefore fails to teach or suggest, at least, "...presence of the update service in the electronic device being determinable by the network, wherein when enabled the update service indicates to the network capability of the electronic device to update the at least one of firmware and software, electronic device employing the at least one update to update the at least one of firmware and software...", as recited in Applicants' amended claim 1. The Applicants respectfully submit that instead, the cited portion of Shah teaches over-the-air parameter administration (OTAPA) of number assignment module (NAM) parameters, which is different from and does not teach or suggest the updating of firmware or software. The Applicants respectfully submit that one of ordinary skill in the art would immediately and unquestioningly recognize that the update of firmware or software in an electronic device, as set forth in the Applicants' amended claim 1, is not the same thing as the mere storage of a parameter value in a NAM, as taught by Shah.

The Office Action also cites Shah at column 2, lines 30-60 as teaching "... a network comprising an update service in the electronic device, presence of the update service in the electronic device being determinable by the network, wherein when enabled the update service indicates to the network capability of the electronic device to update at least one of firmware and software, electronic device employing the at least one update to update the at least one of firmware and software." Applicants respectfully disagree.

According to column 2, lines 30-60 of Shah:

> In an exemplary embodiment of the present invention, the procedure for Over-The-Air Parameter Administration (OTAPA) utilizes the over-the-air programming protocol and procedures which support the Over-The-Air Service Provisioning (OTASP) feature in accordance with established industry standards (TIA/EIA/IS-683). The mobile phone is programmed with a service option for changing the NAM parameters--the Parameter Administration Service Option (PASO), which includes assignment of a PASO number. The mobile phone will also have one or more parameter change codes (PCCs) in its memory. The network possesses means for determining whether a mobile phone is OTAPA capable. In this procedure, the network base station

> sends a General Page Message to the mobile phone using the PASO number. After first verifying its identity using the standard Authentication process, if the mobile phone has OTAPA capability, it responds with a Page Response Message, indicating support for the PASO by sending the PASO number. If the mobile station does not support the option, the response will indicate that the option is not available. Once the presence of the option is confirmed, the base station transmits a Channel Assignment Message, telling the mobile station to proceed to the Traffic Channel. For security reasons, the Signaling Message Encryption (SME) is used in the Channel Assignment Message. Use of encryption is enforced, and, where encryption is optional, if the encryption mode is not enabled, the mobile station will enter into the Service Negotiation process on the Traffic Channel and will request the other service option, indicating that the PASO is not supported, or will terminate the call according to the Call Release Procedure.

The Applicants respectfully submit that neither this portion of Shah, which was also explicitly cited by the Office Action, nor any other portion or figure of Shah teaches or suggests anything with respect to the update of firmware or software, and that Shah therefore fails to teach or suggest, at least, "…presence of the update service in the electronic device being determinable by the network, wherein when enabled the update service indicates to the network capability of the electronic device to update the at least one of firmware and software, electronic device employing the at least one update to update the at least one of firmware and software…", as recited in the Applicants' amended claim 1. The Applicants respectfully submit that instead, the cited portion of Shah teaches over-the-air parameter administration (OTAPA) and over-the-air service provisioning (OTASP) features of IS-683 for programming parameters in a number assignment module (NAM), and the use of a parameter administration service option (PASO) number, which is different from and does not teach or suggest the updating of firmware or software. The Applicants respectfully submit that the update of firmware or software in an electronic device, as set forth in the Applicants' claim 1, is different from and does not teach or suggest the mere storage of a parameter value in a NAM, as taught by Shah.

Therefore, the Applicants respectfully submit that Shah also fails to teach or suggest the admitted shortcomings of Moles, and that neither Moles nor Shah, nor the combination of Moles and Shah, teaches or suggests "...presence of the update service in the electronic device being determinable by the network, wherein when enabled the update service indicates to the network capability of the electronic device to update the at least one of firmware and software, electronic device employing the at least one update to update the at least one of firmware and software...", as recited in the Applicants' claim 1.

In addition, Applicants respectfully submit that neither Moles, nor Shah, nor the combination of Moles and Shah teach or suggest "...wherein one or more parameters specific to updating of firmware and software in the electronic device are provisioned during provisioning of a number assignment module (NAM) in the electronic device, by the network...", as recited by Applicants' amended claim 1.

Based at least upon the above, the Applicants respectfully submit that the proposed combination of Moles and Shah fails to teach all of the limitations of the Applicants' amended claim 1, as required by M.P.E.P. §2142, that the Office has failed establish a *prima facie* case of obviousness, and that a rejection of amended claim 1 under 35 U.S.C. §103(a) cannot be maintained.

Therefore, for at least the reasons set forth above, the Applicants respectfully submit that the Applicants' amended claim 1 is allowable over the proposed combination of Moles and Shah. The Applicants respectfully submit that amended claim 1 is an independent claim. Because claims 2-10 depend either directly or indirectly from amended claim 1, the Applicants respectfully submit that claims 2-10 are also allowable over Moles and Shah, as well. Therefore, the Applicants respectfully request that the rejection of claims 1-10 under 35 U.S.C. §103(a), be withdrawn.

Rejection of Claims 11 - 15

With regard to amended claim 11, the Applicants respectfully submit that the proposed combination of Moles and Shah does not teach, suggest, or disclose, for example, "...[a] mobile electronic device network adapted to update electronic devices

and perform over-the-air number assignment module parameter provisioning, the network comprising an electronic device comprising one of firmware and software, the electronic device also comprising number assignment module parameters specific to updating one or both of firmware and software, the electronic device being communicatively coupled to at least one server; and wherein presence of support for at least one of a firmware update service option and a software update service option in the electronic device is determinable by the network, wherein when enabled, the presence of support for the at least one of a firmware update service option and a software update service option indicates to the network that the electronic device is capable of updating one of firmware and software, wherein the electronic device is adapted to communicate the presence of support for the one of the firmware update service option and software update service option to the network, and wherein the electronic device is also adapted to communicate device specifications to the network when the network attempts to provision the number assignment module parameters."

The Applicants appreciates recognition in the Office Action that Moles does not disclose "...a network wherein presence of support for the at least one of a firmware update service option and a software update service option in the electronic device determinable by the network, wherein when enabled, the presence of support for the at least one of the firmware update service option and a software update service option indicates to the network that the electronic device is capable of updating one of firmware and software, wherein the electronic device is adapted to communicate the presence of support for the one of the firmware update service option and software update service option to the network." Office Action, page 14. The Office Action, however, alleges that Shah remedies these admitted shortcomings of Moles, and cites Shah at Abstract and at column 3, lines 30-60. The Applicants respectfully submit that column 3, lines 30-60 are unrelated to the issue of the rejection, and assumes that the Examiner meant to cite column 2, lines 30-60. If the Applicants' assumption is incorrect, the Applicants respectfully request that the Examiner contact the Applicants' representative, listed below. The Applicants respectfully disagree with what the proposed combination of Moles and Shah allegedly teaches or suggests.

In addition, Applicants respectfully submit that neither Moles, nor Shah, nor the combination of Moles and Shah teach or suggest "...an electronic device comprising one of firmware and software, the electronic device also comprising number assignment module parameters specific to updating one or both of firmware and software ...", as recited by Applicants' amended claim 11.

The Applicants respectfully submit that the rejection of claim 11 relies on alleged teaching of Shah (i.e., Abstract and column 2, lines 30-60) that the Applicants addressed above with respect to claim 1. Accordingly, the Applicants respectfully submit that Shah fails to remedy the shortcomings of Moles, for at least the reasons set forth above with respect to the rejection of claim 1. The Applicants therefore respectfully submit that the proposed combination of Moles and Shah fails to teach or suggest all of the limitations of the Applicants' claim 11, as required by M.P.E.P. §2142, and that a rejection of amended claim 11 under 35 U.S.C. §103(a) cannot stand.

Therefore, for at least the above stated reasons, the Applicants respectfully submit that the Applicants' amended claim 11 is allowable over the proposed combination of Moles and Shah. The Applicants respectfully submit that amended claim 11 is an independent claim. Because claims 12-15 depend either directly or indirectly from claim 11, the Applicants respectfully submit that claims 12-15 are allowable over Moles and Shah, as well. Therefore, the Applicants respectfully request that the rejection of claims 12-15 under 35 U.S.C. §103(a), be withdrawn.

Rejection of Claims 16 - 23

With regard to claim 16, the Applicants respectfully submit that the combination of Moles and Shah fails to teach, suggest, or disclose, for example, "...[a] method of updating software in a wireless communication device in a wireless network, the method comprising determining a value of one of a firmware update service option number and a software update service option number in the wireless communication device by the wireless network; and downloading one of a firmware update and a software update from a server in the wireless network, if one of the firmware update service option

number and the software update service option number is determined to have a predetermined value."

The Applicants appreciate recognition in the Office Action that Moles does not disclose "...determining a value of one of a firmware update service option and a software update service option in the wireless communication device by the wireless network, and downloading an update from a server if one of the firmware update service option number is determined to have a predetermined value." Pages 18-19. The Office Action, however, alleges that Shah remedies the admitted shortcomings of Moles, and cites Shah at Abstract and at column 2, lines 30-60. The Applicants respectfully disagree.

The Applicants respectfully submits that the rejection of claim 16 relies on alleged teaching of Shah (i.e., Abstract and column 2, lines 30-60) that the Applicants addressed above with respect to claims 1 and 11. The Applicants respectfully submit that Shah fails to remedy the shortcomings of Moles, for at least the reasons set forth above with respect to the rejection of claims 1 and 11. The Applicants therefore respectfully submit that the proposed combination of Moles and Shah fails to teach or suggest all of the limitations of Applicants' claim 16, as required by M.P.E.P. §2142, and that a rejection of claim 16 under 35 U.S.C. §103(a) cannot stand.

Therefore, for at least the above stated reasons, the Applicants respectfully submit that Applicants' claim 16 is allowable over the proposed combination of Moles and Shah. Applicants respectfully submit that claim 16 is an independent claim. Because claims 17-23 depend either directly or indirectly from claim 11, Applicants respectfully submit that claims 17-23 are allowable over Moles and Shah, as well. Therefore, the Applicants respectfully request that the rejection of claims 17-23 under 35 U.S.C. §103(a), be withdrawn.

Rejection of Claims 24 - 30

With regard to claim 24, Applicants respectfully submit that the combination of Moles and Shah fails to teach, suggest, or disclose, for example, "...[a] computer-readable storage, having stored thereon a computer program having a plurality of code

sections enabling over-the-air updating of at least one of firmware and software in an electronic device via a wireless network, the code sections executable by a processor for causing the processor to perform the operations comprising: receiving at least one message from a server over the wireless network as part of an over the air parameter administration process, the message comprising a service option parameter; determining whether a value of the service option parameter corresponds to one of a firmware update service option and a software update service option; and engaging in over the air updating of the at least one of firmware and software of the electronic device via the wireless network, if it is determined that the value of the service option parameter corresponds to the one of a firmware update service option and a software update service option."

The Applicants appreciate recognition in the Office Action that Moles does not disclose "...a storage comprising: receiving at least one message from a server over the wireless network as part of an over the air parameter administration process, the message comprising a service option parameter; determining whether a value of the service option parameter corresponds to one of a firmware update service option and a software update service option; and engaging in over the air updating of the at least one of firmware and software of the electronic device via the wireless network, if it is determined that the value of the service option parameter corresponds to the one of a firmware update service option and a software update service option." Page 25. The Office Action, however, alleges that Shah remedies these admitted shortcomings of Moles, and repeatedly cites Shah at Abstract and at column 2, lines 30-60, as teaching the missing elements. Applicants respectfully disagree.

Applicants respectfully submit that the rejection of claim 24 relies on alleged teaching of Shah (i.e., Abstract and column 2, lines 30-60) that Applicants addressed above with respect to claims 1, 11, and 16. Applicants respectfully submit that Shah fails to remedy the admitted shortcomings of Moles, for at least the reasons set forth above with respect to the rejection of claims 1, 11, and 16. Applicants therefore respectfully submit that the proposed combination of Moles and Shah fails to teach or

suggest all of the limitations of Applicants' claim 24, as required by M.P.E.P. §2142, and that a rejection of claim 24 under 35 U.S.C. §103(a) cannot stand.

Therefore, for at least the above stated reasons, the Applicants respectfully submit that Applicants' claim 24 is allowable over the proposed combination of Moles and Shah. Applicants respectfully submit that claim 24 is an independent claim. Because claims 25-30 depend either directly or indirectly from claim 24, Applicants respectfully submit that claims 25-30 are allowable over Moles and Shah, as well. Therefore, the Applicants respectfully request that the rejection of claims 24-30 under 35 U.S.C. §103(a), be withdrawn.

Conclusion

In general, the Office Action makes various statements regarding the claims of the Application and the cited references that are now moot in light of the above. Thus, Applicants will not address such statements at the present time. However, Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

The Applicants believe that all of pending claims 1-30 are in condition for allowance. Should the Examiner disagree or have any questions regarding this submission, the Applicants invite the Examiner to telephone the undersigned at (312) 775-8000.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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